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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,609	11/29/2001	Takao Takiguchi	684.3318	2294

5514 7590 01/15/2003

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EXAMINER

KIELIN, ERIK J

ART UNIT	PAPER NUMBER
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2813

DATE MAILED: 01/15/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/995,609

Applicant(s)

TAKIGUCHI ET AL.

Examiner

Erik Kielin

Art Unit

2813

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

This action responds to the Amendment filed 19 December 2002, Paper No. 14.

#### *Claim Rejections - 35 USC § 102*

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

1. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent

Application 2002/0034656 A1 (**Thompson et al.**).

**Thompson** discloses a metal coordination compound, specifically the compound labeled “vinylpyridines,” represented by the following formula indicated as (1), wherein M denotes Ir, Pt, Rh or Pd; n is 2 or 3; R<sub>1</sub> and R<sub>2</sub> independently denote a linear or branched alkyl group having 1-20 carbon atoms and capable of having a -CO-O- or -O-CO-; and CyN denotes a cyclic group containing nitrogen atom connected to M. The “vinylpyridine” ligand shown in Fig. 49 is CyN showing R<sub>1</sub> as a hydrogen (as the claim is presently amended to include) and R<sub>2</sub> as an alkyl group. (See Fig. 49; paragraphs [0048], [0049], [0052], and [0183].)

#### *Response to Arguments*

2. Applicant's arguments filed 19 December 2002 have been fully considered but they are not persuasive.

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Applicant argues (p. 10 of the Response) that instant claim 1 is limited to the compound of formula (1) wherein the ligands to the metal M are each identical. Examiner notes that instant claim 1 states that "n" may be 2 or 3, and therefore reads on the  $L_2MX$  compound of Thompson, wherein Thompson denotes the ligand as "L." Applicant has not claimed that all ligands must be the same, so even if n is 2, in instant claim 1, then the open-ended claim preamble leaves and additional position open for an additional ligand since at least iridium Ir and platinum Pt are a 6-coordinate metals, as clearly shown in Thompson, and as notoriously well know to those of ordinary skill. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Further in this regard, Applicant argues (p. 10 of the Response) that the ligands in the Thompson reference, as shown in Fig. 49, are limited to metal coordination compounds having the formula  $L_2MX$ . Examiner respectfully disagrees. Thompson indicates that the X ligand is only to "modify the physical properties (for example, a hole trapping group could be added to [the] ligand.)" (Emphasis added. See paragraph [0110].) Accordingly, the luminescence is obtained from the L ligands, said luminescence only being *modified* by the X ligand. (See additionally Thompson, paragraph [0052] where this point is verified.) In as much as **Thompson** teaches that the ligands  $L_3M$ , and that the L ligands may be the same or different, the use of 3 identical ligands in Fig. 49 is at least suggested, since it is the L ligands that which primarily engenders the luminescence properties, as stated in paragraph [0052]. This point is presently moot since the instant claim 1, as noted above claims that the metal coordination complex may have only 2 identical ligands, i.e. n=2 or 3.

*Conclusion*

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erik Kielin whose telephone number is 703-306-5980. The examiner can normally be reached on 9:00 - 19:30 on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Whitehead, Jr., can be reached at 703-308-4940. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9318 for regular communications and 703-872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



Erik Kielin

January 13, 2003